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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,721	12/29/2000	John Brixius	17209-005	8324
54205 7590 06/07/2007 CHADBOURNE & PARKE LLP 30 ROCKEFELER PLAZA NEW YORK, NY 10112			EXAMINER PATEL, JAGDISH	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 06/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/751,721

Applicant(s)

BRILIUS, JOHN

Examiner

JAGDISH PATEL

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3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/1/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 3/1/07.

Response to Amendment

2. Claims 22 and 23 have been amended. Claims 1-7, 9-18 and 20-23 are currently pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-7, 9, 12-18 and 22-23 have been fully considered but they are not persuasive. See respective sections of claim rejections which details response to the applicant's arguments. Rejection of claims 10 and 11 over prior art have been withdrawn. Rejection of claims 10 and 11 under 35 USC 103(a) has been withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

5. Claims 22 and 23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The rejection of claims 22 and 23 under 35 USC 101 have been maintained. The amendment which replaces the word "signal" with "instruction" does not change the scope of the invention. ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). The instant claims recite digital data

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stream which embodies computer instructions. The digital data stream does not fall into any statutory class of invention permitted by 35 USC 101 (process, machine, manufacture, or composition of matter).

Rejection claims 22 and 23 under 35 USC 101 have been maintained.

Claim Rejections - 35 USC § 112

6. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The applicant points to section of the specification (para [0014]). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 10 refers to a type a security (physical restricted security) involved in the trade of method of claim 1. As previously pointed out by the examiner the indefiniteness of the claim arises from the fact that the method steps of claim 1 do not depend upon the type of a security, whether it is physical or electronic because the step of receiving data, receiving verification and generating documentation are all computer-implemented as per claim 1. Therefore, the process steps of claim 1 do not depend upon the whether the trade of a security is based on a specific type of security such as a physical security. In other words the steps of receiving, generating documentation and receiving an electronic signature are performed independent of the type of security involved in the trade. Claims 10 and 11 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Rejection claims 10 and 11 under 35 USC 112 have been maintained.

Claim Rejections - 35 USC § 103

8. Response to Arguments: Applicant's argument that the cited reference Wall Street does not address "generating documentation supportive of the trade where the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied" as required by claim 1. The examiner respectfully disagrees with the applicant's interpretation of the Wall Street. As stated in the Abstract, Wall Street teaches the system runs through 45 restrictions (legal opinions) and blocks the execution of a transaction (trade) if it violates a regulation. Wall Street allows for overriding a restriction which is identified by a trader. It is obvious that the system of Wall Street generates identification of the restriction (legal opinion) and documents this fact when at least one of the 45 restrictions is violated. This fact is more evident in view of teaching that the system of Wall Street also generates documentation in the form an audit trail. The audit trail inherently allows for scrutiny of trades carried out by the portfolio managers in terms the trades being compliance with the predefined trading restrictions (regulations) carried out by the portfolio managers of the mutual fund. Therefore, the examiner asserts that the audit trail generated by the Compalert module of the trading system disclosed in Wall Street inherently discloses the aforementioned step of generating documentation supportive of the trade as stated in the claim.

Base upon the foregoing explanation, claims 1-7, 9, 12-18 and 20-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wall Street and Millard. (see previous office action dated 12/1/2006).

Claim Rejections - 35 USC § 101

9. The rejection of claims 22 and 23 under 35 USC 101 have been maintained. The amendment which replaces the word “signal” with “instruction” does not change the scope of the invention. (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). The instant claims recite digital data stream which embodies computer instructions. The digital data stream does not fall into any statutory class of invention permitted by 35 USC 101 (process, machine, manufacture, or composition of matter).

Rejection claims 22 and 23 under 35 USC 101 have been maintained.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

5/29/07